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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/200,430	11/27/1998	KAORU YAMAMOTO	041465-5053	4823
9629	7590	04/22/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ONUAKU, CHRISTOPHER O	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/200,430

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

Christopher O. Onuaku

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/05 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5,18&19 are rejected under 35 U.S.C. 101 because the claims are non-statutory descriptive material recorded on computer readable medium; the material is not structurally and functionally interrelated to the medium but is merely carried by the

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medium. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not the claim make statutory. See MPEP Section 2106.IV.B.1.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3&5-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Heo (US 6,741,796).

Regarding claim 1, Heo discloses a digital versatile disk (DVD), an apparatus and method for playing the DVD, including an audio DVD and apparatus and method for playing the same, comprising:

- a) a DVD information record medium ( see Fig.1, col.4, lines 56-67);
- b) substantial information including video information (picture signal) and audio information (sound signal) which are related to each other ( see Fig.1; col.4, line 45 to col.5, line 15);
- c) first reproduction control information to reproduce the video information and the audio information out of the substantial information only for a first reproduction apparatus with video and audio reproduction ability (see Fig.6 and video title set

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information (VTSI) ; col.5, line 59 to col.6, line 11; and col.28, lines 7-17, which discloses playing video and audio during the DVD-Video mode);

d) first management information only for the first reproducing apparatus (see Fig.6 and vide title set information (see Fig.4 and video manager (VMGI); col.5, lines 40)-52;

e) second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproduction apparatus that is able to reproduce audio, but is not able to reproduce video (see Fig.14 and audio title set information (ATSI); col.9, lines 17-37);

f) second management information only for the second reproduction apparatus (see Fig.12 and audio manager (AMGI); col.8, line 66 to col.9, line 10);

g) wherein the substantial information, the first reproduction control information and the first management information are recorded in the video zone (see Fig.2,4&6 and VTSI,VMGI and the discussions above); and the second reproduction control information and the second management information are recorded in the audio zone (see Fig.10,12&14 and ATSI and AMGI and the discussions above); and

h) wherein the first reproduction control information is Video Title Set Information (VTSI) (See Fig.6 and the discussions above), and the first management information is Video Manager (VMG) information (see Fig.4 and the discussions above), the second reproduction control information is Audio Title Set information (ATSI) (see Fig.14 , ATSI and the discussions above), and the second management information is Audio Manager (AMG) information (see Fig.12, AMGI and discussions above

Regarding claim 2, Heo discloses wherein the first reproduction control information and the second reproduction control information prescribes a reproduction of a same portion of the substantial information ( see Fig.31, col.28, lines 7-17), here when the DVD-Video mode is selected, both the video and audio are played.

Regarding claim 3, Sakai discloses wherein:

a) the first reproduction control information divides the substantial information into a plurality of first information units and prescribes a reproduction control of the first information units (see col.4, lines 56-67), here the video title set directory shows that the directory contains a plurality of files, and file locations, of which the file names shall be assigned to identify each of the video files

b) the second reproduction control information divides the substantial information into a plurality of second information units, which are different from the information units, and prescribes a reproduction control of the second information units (see col.4, lines 56-67), here the audio title set directory shows that the directory contains a plurality of files, and file locations, of which the file names shall be assigned to identify each of the audio files.

Regarding claim 4, Sakai discloses wherein the second reproduction control information prescribes a reproduction of the substantial information in a reproduction order which is different from that of the first reproduction control information with respect

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to a same portion of the substantial information ( see page 6, lines 10-17; and col.11, lines 28-30), here in a case of picture signal reproduction, the record (field or frame recording) mode is judged and in the case of the sound signal reproduction, the time mode is judged. Since during recording, the sound signal is recorded based on time mode, and the picture signal is recorded based on the recording mode, the sound signal reproduction order would be different from the picture signal reproduction order.

Regarding claim 5, Heo discloses another substantial information including only audio information recorded in the audio zone ( see col.8, 13-20).

Regarding claim 6, the claimed limitations of claim 6 are accommodated in the discussions of claim 1 above, and Heo further discloses;

- a) an information reproducing apparatus ( see Fig.29);
- b) a reading device for reading the substantial information, the first reproduction control information and the second reproduction control information from the record medium ( see claim 1 discussions; additionally, see Fig.29, and pickup device 312; col.24, lines 53-62);

- c) a reproducing device which reproduces the substantial information in accordance with the first management information and the first reproduction control information when a reproduction of the video information and the audio information is instructed (see Fig.29\$31; col.24, line 39 –62 &Fig.31and col.28, lines 7-17), here once the system determines a DVD-Video, and there is a demand to produce a title, the

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video, sub-picture and audio data of the selected title are played.; and reproducing the substantial information in accordance with the second management information and the second reproduction control information when a reproduction of only the audio information is instructed ( see claim 1 discussions; also see Fig.29&31; col.24, line 39 – 62 &Fig.31, col.27, line 32 to col.28, line 6), here once the system determines a DVD-Audio, selected audio title is played.

Regarding claim 7, the claimed limitations of claim 7 are accommodated in the discussions of claim s1&6 above, .

Regarding claim 8, the claimed limitations of claim 8 are accommodated in the discussions of claims1&6 above.

Regarding claim 9, the claimed limitations of claim 9 are accommodated in the discussions of claims 1&6 above.

Regarding claim 10, the claimed limitations of claim 10 are accommodated in the discussions of claims 1&6 above.

Regarding claim 11, the claimed limitations of claim 11 are accommodated in the discussions of claims 16 above.



Regarding claim 12, the claimed limitations of claim 12 are accommodated in the discussions of claims 5&6 above.

Regarding claim 13, the claimed limitations of claim 13 are accommodated in the discussions of claims 5&7 above.

Regarding claim 14, the claimed limitations of claim 14 are accommodated in the discussions of claims 5&8 above.

Regarding claim 15, the claimed limitations of claim 15 are accommodated in the discussions of claims 5&9 above.

Regarding claim 16, the claimed limitations of claim 16 are accommodated in the discussions of claims 5&10 above.

Regarding claim 17, the claimed limitations of claim 17 are accommodated in the discussions of claims 5&11 above.

Regarding claim 18, the claimed limitations of claim 18 are accommodated in the discussions of claim 1 above.

Regarding claim 19, the claimed limitations of claim 19 are accommodated in the discussions of claim 1 above.

Regarding claim 20, the claimed limitations of claim 20 are accommodated in the discussions of claim 6 above.

Regarding claim 21, the claimed limitations of claim 21 are accommodated in the discussions of claim 6 above.

Regarding claim 22, the claimed limitations of claim 22 are accommodated in the discussions of claim 6 above.

Regarding claim 23, the claimed limitations of claim 23 are accommodated in the discussions of claim 6 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heo in view of Sakai (GB 2 225 147).

Regarding claim 4, Heo fails to explicitly disclose wherein the second reproduction control information prescribes a reproduction of the substantial information in a reproduction order which is different from that of the first reproduction control information with respect to a same portion of the substantial information.

Sakai discloses an electronic still camera which can distinguishably indicate the picture signal and the sound signal during recording and reproducing, comprising wherein the second reproduction control information prescribes a reproduction of the substantial information in a reproduction order which is different from that of the first reproduction control information with respect to a same portion of the substantial information (see page 6, lines 10-17; and page 11, lines 26-30), here in a case of picture signal reproduction, the record (field or frame recording) mode is judged and in the case of the sound signal reproduction, the time mode is judged. Since during recording, the sound signal is recorded based on time mode, and the picture signal is recorded based on the recording mode, the sound signal reproduction order would be different from the picture signal reproduction order.

It would have been obvious to differentiate the VTSl and ATSl order, in order, for example, to facilitate the determination of when the DVD-Video is being reproduced and when the DVD-Audio is being reproduced.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from this examiner should be directed to Christopher Onuaku whose telephone number is (571) 272-7379. The examiner can normally be reached on Tuesday to Thursday from 7:30 am to 5:00 pm. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Andy Faile, can be reached on (571) 272-7375.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

and (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service whose telephone number is (703) 306-0377.

*hoo*  
COO

4/15/05.

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